

REMARKS

Claims 1, 4, 6-30 and 33-55 are pending. Claims 1, 6, 30, and 33 have been amended. No new matter has been added.

Claims 1, 6-9, 11-14, 18, 20-30, 33-36, 38-43, 47, and 49-55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,220,501 to Lawlor et al. ("Lawlor") in view of U.S. Patent No. 5,485,370 to Moss ("Moss") and further in view of U.S. Patent No. 5,705,798 to Tarbox ("Tarbox"). Claims 4, 10, and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlor in view of Moss and Tarbox and further in view of Official Notice. Claims 15-17, 19, 44-46, and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlor in view of Moss and Tarbox and further in view of Munroe, Tony. "Citibank Offers Service Link Through Computers at Home." Washington Times, Washington D.C., Section B, page 7, November 10, 1994 ("Munroe").

Rejection of Claims 1, 6-9, 11-14, 18, 20-30, 33-36, 38-43, 47, and 49-55
under 35 U.S.C. § 103

Claims 1, 6-9, 11-14, 18, 20-30, 33-36, 38-43, 47, and 49-55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlor in view of Moss and further in view of Tarbox. This rejection is respectfully traversed. The Examiner maintains the rejection over Lawlor and Moss and adds Tarbox in this Office Action. However, this rejection is deficient for a few reasons.

First, as previously asserted in a Response to Final Office Action mailed June 24, 2010, the undersigned representative explained that Moss does not qualify as a prior art reference. The Examiner did not respond to this explanation and did not withdraw the rejection in view of Moss. Moss is assigned to Transaction Technology, Inc., was filed on August 25, 1993, and issued on January 16, 1996. The assignee of the present application is Citicorp Development Center, Inc. Transaction Technology, Inc. and Citicorp Development Center, Inc. are commonly owned by the same entity, Citigroup. Accordingly, Moss and the present application are subject to assignment to the same entity. Indeed, Leslie Moss is an inventor of the pending application as well as an inventor of Moss. Because the other inventors listed on the present application and Moss are different, Moss qualifies under 35

U.S.C. § 102(f) because it was invented by another entity. See MPEP 2137.01. Moss also qualifies under 35 U.S.C. § 102(g). For applications filed prior to November 29, 1999 and granted as patents prior to December 10, 2004, 35 U.S.C. § 103(c) is limited on its face to subject matter developed by another person which qualifies as prior art only under subsection (f) or (g) of section 102. *See* MPEP §§706.02(l)(1); 2141.01. As stated above, Moss was developed by another and qualifies as prior art under 35 U.S.C. §§ 102(f) and (g) and is owned by the same entity. Therefore, Moss is unavailable as prior art pursuant to 35 U.S.C. § 103(c).

Second, Tarbox does not cure the deficiencies of Lawlor and Moss. Neither Lawlor, Moss, nor Tarbox teaches “providing user software for installation by a customer of the business host on the at least one home banking terminal, wherein the installed user software enables the personal computer to allow multiple customers of the business host to each select from different languages and enables the computer to access the infrastructure and business software located on the server,” as recited in claim 1 and similarly recited in claims 6, 30, and 33. On page 5 of the Office Action, the Examiner recognizes that Lawlor does not disclose this limitation. The Office Action asserts that Moss, which is not available as a prior art reference, remedies these shortfalls of Lawlor.

The Examiner also asserts that because the “language capabilities are only made available ‘when’ the software is installed,” “the step of installation is not explicitly performed.” As a result, the Examiner asserts that the use of the software in multiple languages is not actively performed. Claims 1, 6, 30, and 33 have been amended to delete the phrase “when,” and so the Examiner’s *prima facie* case of obviousness must set forth software that teaches these capabilities.

The Examiner also asserts that “the nature of who or what downloads the software within the scope of the claimed invention does not alter the claimed invention as a whole.” Claims 1, 30 and 33 recite that the customer is a customer of the business host, the software enables the personal computer (claim 1) or the home banking terminal (claims 30 and 33), and the customer of the business host installing the user software does affect the nature of the personal computer or the home banking terminal, because the personal computer or the home banking terminal would not be able to perform the banking function without the installation

of the user software by the customer of the business host. But the combination of Lawlor with Moss would not have suggested user software for installation by a customer of the business host on the at least one home banking terminal. Lawlor recites, *e.g.*, col. 8, lines 6-19, that no hardware or installation expense is require for the devices. *See also* col. 20, lines 7-10. Moss recites, *e.g.*, col. 5, lines 44-47, that the home terminal has a display, a data input device, telephone electronics, computing electronics, a modem and software to operate the terminal as both a telephone and a general purpose computer. Thus, the home terminal has all software installed and would not have suggested the user installing any software. Accordingly, the combination of Lawlor with Moss would not have suggested user software for installation by a customer of the business host.

Claim 6 recites, among other features, and enables configuration by the user of the remote terminal for a communication method available at a home of a user. As noted above, Lawlor rcites, *e.g.*, col. 8, lines 6-19, that no hardware or installation expense is require for the devices. *See also* col. 20, lines 7-10. Moss recites, *e.g.*, col. 5, lines 44-47, that the home terminal has a display, a data input device, telephone electronics, computing electronics, a modem and software to operate the terminal as both a telephone and a general purpose computer. Further, Lawlor recites, *e.g.*, col. 26, lines 10 and 11, that the terminal dials an appropriate internally-stored telephone number. Thus, the combination of Lawlor with Moss would not have suggested configuration by the user of the remote terminal for a communication method available at a home of a user.

The Examiner attempts to cure the deficiencies of Lawlor and Moss by asserting Tarbox. More specifically, on page 6 of the Office Action, the Examiner asserts that “Tarbox serves as further evidence that the concept of customizing a financial transaction to each individual user based on an identification of the user and his/her language preferences (as seen in col 1, lines 50-61; col. 2, lines 55-65 of Tarbox) was old and well-known in the art of financial transactions.” However, Tarbox does not teach “providing user software for installation by a customer of the business host on the at least one home banking terminal, wherein the installed user software enables the personal computer to allow multiple customers of the business host to each select from different languages and enables the computer to access the infrastructure and business software located on the server,” as recited

in claim 1 and similarly recited in claims 6, 30, and 33. Instead, Tarbox stores preferences on a transaction card, and that card transmits the preferences when the card is used at an ATM. “FIG. 4 illustrates a customized program card ... that is used with terminal 101. The customized program card comprises a memory 401 [that] comprises a program memory space 403 and a data memory space 405. ... Data memory space 405 contains stored data necessary to complete a financial transaction. Stored data may include the card holder’s name, account number, card expiration date, security code and preference indicators. ... Terminal 101 then identifies card 400 as a customized programming card preferably by reading some initial data code stored in data memory 405 of card 400, which data is indicative of a card containing operating instructions to be read by the terminal.” Col. 5, lines 10-53. Because Tarbox recites that the card stores the preferences, Tarbox cannot teach that installed user software enables the personal computer to allow multiple customers to select from different languages.

Further, as asserted in a previous Response, although claim 1 recites that “the home banking terminal is a personal computer,” the Examiner incorrectly maintains that an ATM is equivalent to a personal computer. On page 3 of the Office Action, the Examiner asserts that “The ATM terminal sent to a customer functions as a personal computer and is, thus, effectively a type of personal computer within the scope of Lawlor.” As previously discussed, an ATM and a personal computer operate differently, and Lawlor even teaches away from the use of a personal computer. Claim 1 also recites “providing user software for installation by a customer on the at least one home banking terminal.” Because a customer cannot install any software on an ATM, the ATM is not equivalent to a home banking terminal or a personal computer. The Examiner’s broad interpretation of a personal computer in one claim limitation is contradicted by the next limitation. Indeed, the claim itself distinguishes between an ATM and a home banking terminal by “displaying a first user interface on a screen of the ATM and displaying a second user interface on a screen of the home banking terminal in the user selected language, wherein the first user interface and the second user interface are substantially the same.” So the personal computer (*i.e.*, home banking terminal) is used in the installation of user software and is used to display the second user interface on the screen of the personal computer.

Lawlor's ATM terminals are not equivalent to a personal computer. Lawlor's ATM terminal does not have the functionality of a personal computer. It is well known by one of ordinary skill in the art that a personal computer is a general purpose computer and can perform a variety of functions. In contrast, Lawlor's ATM terminal is not a general purpose computer, as it can only perform certain functions of an ATM. In fact, Lawlor recognizes the existence of personal computers and directly teaches against their use, and instead, Lawlor chooses to use an ATM terminal. Lawlor recognizes the existence of personal computers:

Not long ago, "home banking" was thought to be just around the corner. With the advent of relatively inexpensive, powerful *personal computers*, the computer industry hoped (and predicted) that a personal computer with communications capability (e.g., modem) would soon find its way into every home.

Lawlor, col. 1, lines 20-25 (emphasis added). Lawlor also acknowledges the disadvantages to using a personal computer for Lawlor's intended purpose:

In addition, the cost of providing home banking services have been enormous. Service providers incur very high communications costs in linking their central processors with PC users, banks, and payees (merchants). Many payees also do not accept electronic payments (for lack of substantial volume), forcing service providers to make costly paper-based payments.

Lawlor, col. 2, lines 2-29. Lawlor even recognizes that it is undesirable to require installation of software:

Settlements processing can also be costly, as banks must *install special purpose software* and operating procedures. These and other costs have been passed along to consumers, thereby dampening the demand for home banking services.

Lawlor, col. 2, lines 29-35 (emphasis added). As a result, Lawlor declares personal computers for home banking to be a "failure":

In part because of the problems discussed above, *PC-based home banking is not yet a practical reality* for most consumers. In fact, many home banking programs launched in the past have been declared *failures and discontinued*.

Lawlor, col. 2, lines 45-50 (emphasis added). As a result, Lawlor uses an ATM, which Lawlor believes is different from a personal computer, but Lawlor recognizes that it has only *limited functionality*:

While ATMs are very easy-to-use, they currently allow users to *access only a limited number of bank teller services*.

Lawlor, col. 4, lines 12-14 (emphasis added). Thus, amongst the reasons discussed in the previous Response, Lawlor teaches away from the use of a personal computer.

Therefore, Lawlor, Moss, and Tarbox fail to teach each and every element of claims 1, 6, 30, and 33. Because claims 7-9, 11-14, 18, 20-30, 34-36, 38-43, 47, and 49-55 depend from claims 1, 6, 30, and 33 it is respectfully submitted that these claims are also in condition for allowance. Therefore, the undersigned respectfully requests that the pending rejections under 35 U.S.C. § 103(a) be withdrawn.

Rejection of Claims 4, 10, and 37 under 35 U.S.C. § 103(a)

Claims 4, 10, and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlor in view of Moss and Tarbox and further in view of Official Notice. This rejection is respectfully traversed.

For at least the reasons discussed above with respect to claims 1, 6, 30, and 33, Lawlor and Moss do not teach each and every element of claims 4, 10, and 37. As discussed above, Lawlor and Moss do not teach “installing user software on a plurality of remote terminals available to all users wishing to access the financial services, the plurality of remote terminals including a first terminal and a second terminal, wherein the second terminal is of a different type than the first terminal” or “allowing multiple users of the plurality of remote terminals to configure the user software to reflect each user's preferences, wherein the preferences include a language and to configure a communication method of the user's terminal with a standard international host in accordance with communication methods available at the user's home,” as recited in claim 4. The Examiner concedes that Lawlor does not teach that the configured user preferences include a language and the step of installing user software on a remote terminal is performed by installing the software on a personal data assistant. The Office Action asserts that Moss, Tarbox, and Applicants' alleged admitted prior art remedies these shortfalls of Lawlor. Nevertheless, the Examiner continues to assert that Lawlor's ATM is equivalent to a personal data assistant, which as discussed above, is

improper. Moss, as discussed above, is not available as a prior art reference. Tarbox, as discussed above, fails to cure the deficiencies of Lawlor and Moss.

Claim 4 recites, among other features, allowing multiple users to configure a communication method of the user's terminal with a standard international host in accordance with communication methods available at the user's home. As discussed above, with respect to claim 6, the combination of Lawlor with Moss and Tarbox would not have suggested configuration by the user of the remote terminal for a communication method available at a home of a user. Tarbox, as discussed above with respect to claim 1, fails to cure the deficiencies of Lawlor and Moss.

Therefore, the combination of Lawlor with Moss and Tarbox would not have suggested allowing multiple users to configure a communication method of the user's terminal with a standard international host in accordance with communication methods available at the user's home, as recited in claim 4. Applicant's alleged admitted prior art, as applied to claim 4, do not remedy these shortfalls of Lawlor, Moss, and Tarbox. For at least the foregoing reasons, the combination of Lawlor with Moss, Tarbox, and Applicant's alleged admitted prior art cannot reasonably be considered to have suggested the combination of all of the features recited in claim 4.

Further, the combination of Lawlor with Moss, Tarbox, and Applicant's alleged admitted prior art cannot reasonably be considered to have suggested the combinations of all of the features recited in claims 10 and 37 for at least the dependence of these claims on allowable base claims, as well as for the separately patentable subject matter that each of these claims recites. Therefore, the undersigned respectfully requests that the pending rejections under 35 U.S.C. § 103(a) be withdrawn.

Rejection of Claims 15-17, 19, 44-46, and 48 under 35 U.S.C. § 103(a)

Claims 15-17, 19, 44-46, and 48 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlor in view of Moss and Tarbox and further in view of Munroe. This rejection is respectfully traversed. For at least the reasons discussed above, Lawlor, Moss, and Tarbox do not teach each and every element of claims 1, 6, 30, and 33. Munroe fails to cure the deficiencies of Lawlor, Moss, and Tarbox. Because the independent claims are

believed to be allowable, the claims depending therefrom are also believed to be in condition for allowance. Therefore, the undersigned respectfully requests that the pending rejections under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

The undersigned representative respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution might be advanced by discussing the application with the undersigned representative, in person or over the telephone, we welcome the opportunity to do so. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account 19-3140.

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Respectfully submitted,

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